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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,792	02/24/2004	Kishio Shibato	Q79832	2181

7590

06/02/2006

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EXAMINER
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PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/784,792

Applicant(s)

SHIBATO ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 2/4/06 IDS.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-21 is/are rejected.
- 7) ☒ Claim(s) 11-13, 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/24/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The Applicants' preliminary amendment filed on February 24, 2004 is acknowledged. Claims 1-9 are deleted. Claims 10-11 and 13-18 are amended. Claims 19-21 are added. Now, Claims 10-21 are pending.

#### ***Specification***

2. The disclosure is objected to because of the following informalities:  
Applicants should update the status of the U.S. Application 10/111,132.  
Applicants should update the abstract.  
Appropriate correction is required.

#### ***Claim Objections***

3. Claims 11-13 and 20 are objected to because of the following informalities:  
In Claim 11 (line 2), should "comprises further" be -- further comprises --?  
In Claim 20 (line 5), should "an organosilicate" be -- a non-polymerizable organosilicate --?  
Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 10 (line 6), should “non-polymerizable” be -- non-radical polymerizable --. Applicants indicate that the amendment of the instant claim is supported by the specification (page 24). The organosilicates described in the specification (page 24, 3<sup>rd</sup> paragraph) are considered as non-radical polymerizable. They are not considered as non-polymerizable in general because they can be condensed among themselves to form polymers.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 10-11 and 13-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-7 and 9-15 of U.S. Patent No. 6 797 391. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason: Claims 1, 4-7 and 9-15 discloses a coating composition comprising component F) a modified resin and a method of coating that obviously read on Claims 10-11 and 13-19 of the present invention.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 10-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto (US 6 103 387).

For Claims 10-13, 18 and 20-21, Yamamoto discloses, a stain resistant coating composition comprising components A) to C). (col. 3, lines 54-57) Component B) can be prepared by polymerizing monomer mixture comprising **epoxy** containing monomers, **hydroxy** containing monomers such as 2-hydroxyethylacrylate, etc. in the presence of a **non-polymerizable alkoxysilane** of formula (4). (col. 10, line 61 to col. 11, line 67 and col. 13, lines 24-40) Yamamoto further teaches that polyvinyl ethers prepared by the reaction of hydroxyalkyl vinyl ethers with compounds having polyfunctional carboxyl group to be used in the monomer mixture for preparing component B), which reads on the optional component B) of Claim 10. For Claim 11, Component C) can be a silica sol. (col. 13, line 41 to col. 14, line 21) In another embodiment, component A) can be component A') (col. 25, lines 49-67) that is prepared by polymerizing a monomer mixture comprising a **hydroxy** containing monomer (col. 27, lines 5-17), an **epoxy** containing monomer (col. 28, lines 9-28), a **carboxyl** containing monomer (col. 27, lines 18-42), etc. In the later embodiment, Yamamoto is silent on the polymerizing the monomer mixture in the presence of component C). However, with respect to later embodiment, these claims are product-by-process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a

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product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process” In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

For Claims 14-17 and 19, Yamamoto further teaches a method of coating. An under clear coating of acrylic resin/aminoplastic resin can be applied in a multilayer coating. (col. 23, line 13 to col. 25, line 67 and Examples)

10. Claims 10-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Nambu (EP 1 013 730).

The following column and line numbers are based on Nambu’s U.S. equivalent, US 6 316 572.

Nambu discloses a stain resistant coating composition comprising component A) prepared by polymerizing a mixture of compound x) an **epoxy** containing radical polymerizable monomer and compound y) a **carboxyl** containing vinyl monomer; component B) and component C). (col. 2, line 22 to col. 3, line 9) Compound y) can further contain a **hydroxy** group. (col. 3, lines 23-34) **Hydroxy** containing monomers can also be used for preparing component A) (col. 7, lines 43-62) Other monomers such as methyl (meth)acrylate, etc. can be

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used for preparing component A). (col. 6, lines 39-67) Component C) can be a **non-polymerizable organosilicate** as described in col. 17, lines 38-62. Nambu is silent on polymerizing the mixture of compound x) and compound y) in the presence of component C). However, these claims are a product-by-process claims. “Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process” In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Component B) can contain carboxylic acid or anhydride, etc. (col. 14, lines 15-53) The amounts of components A), B) and C) are described in col. 4, lines 39-44, col. 16, line 64 to col. 17, line 9 and Examples. Nambu further teaches a method of coating as described in col. 21, line 6 to col. 22, line 25 and Examples. For Claim 11, note that the aforementioned component C) can read on the organosilicate in the instant.

11. Claims 10-15 and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by JP847 (JP 11-116847).



JP847 discloses a stain resistant coating composition comprising an organic resin A) and a non-polymerizable organosilicate B) of formula I. ([0012]-[0018] and [0089]) Component A) can contain can be derived from monomer mixture comprising hydroxy containing monomers such as polyoxyalkylene glycol mono-(meth)acrylate, etc.) and epoxy containing monomers. ([0029]-[0030]) JP847 is silent on the specific process of polymerizing the monomer mixture in the presence of component B). However, these claims are a product-by-process claims. “Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process” In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). The monomer mixture for preparing component A) can comprise monomers containing carboxylic acid or anhydride groups. ([0030]) JP847 further teaches a method of coating. ([0110]-[0112] and Examples) For Claim 11, note that the aforementioned component B) can read on the organosilicate in the instant claim.


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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
May 23, 2006

  
Kuo-Liang Peng  
Primary Examiner  
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